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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,633	12/08/2003	Philip E. Eggers	NET 2-100	4273
266	7590	06/26/2006		
MUELLER AND SMITH, LPA MUELLER-SMITH BUILDING 7700 RIVERS EDGE DRIVE COLUMBUS, OH 43235			EXAMINER HOEKSTRA, JEFFREY GERBEN	
			ART UNIT 3736	PAPER NUMBER

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/730,633	<b>Applicant(s)</b> EGGERS ET AL.	
	<b>Examiner</b> Jeffrey G. Hoekstra	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 13-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 6, 7 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Species I, drawn to claims 1-12, in the reply filed on 05/22/2006 is acknowledged. The traversal is on the ground(s) that Species A-C all include a drive assembly engageable with a plurality of elongate thin leafs that deploy outwardly and then contract to a given extent. This is not found persuasive because Species B and C positively recite divergent structural limitations for (a) the distal arrangement of the plurality of elongate thin leafs and (b) mechanical deployment and control of a tissue volume removal system, i.e. Species B and C both recite (a) alternate structural embodiments and/or configurations of the plurality of elongate thin leafs that deploy outwardly and then contract to a given extent and (b) alternate structural embodiments and/or configurations for mechanical deployment and control of a tissue volume removal system including a plurality of stopping and driving means.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 13-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 05/22/2006.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Priority***

4. Applicant's desire to obtain the benefit of the filing date of the prior application 10/630,336 filed on 07/30/2003 under 35 U.S.C. 120 and 37 CFR 1.78 is acknowledged.

***Claim Objections***

5. Claims 6, 7, and 9 are objected to because of the following informalities:

6. The term "about" in claims 6, 7, and 9 is a relative term that appears to render the claims indefinite. The term "about" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The distinct dimensions of the (a) leaf drive component, (b) leaf cable guide, and (c) guide channel are unclear.

7. Appropriate correction is required.

***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18, 26, 30, and 35 of U.S. Patent No. 6,287,304 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims positively recite the as claimed structural limitations of the instant case although the elements are referenced with a different name, for example the plurality of elongate thin leafs in the instant case is claimed as an array of thin flexible electrically conductive first secondary electrodes.

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10. Claims 1, 3-4, and 12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 8, 15-17, 20, 22, and 23 of U.S. Patent No. 6,471,659 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims positively recite the as claimed structural limitations of the instant case although the elements are referenced with a different name, for example the support member of the instant case is claimed as a delivery cannula.

11. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,923,809 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case is merely a broader recitation of the patented claims.

12. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 30 of U.S. Patent No. 6,923,809 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case is merely a broader recitation of the patented claims.

13. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/630,336. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims positively recite the as claimed structural limitations of the instant case although the elements are referenced with a

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different name, for example the support member of the instant case is claimed as a delivery member.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 18 of copending Application No. 10/630,336. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims positively recite the as claimed structural limitations of the instant case although the elements are referenced with a different name, for example the support member of the instant case is claimed as a support assembly.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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16. Claims 1-5, 8, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Burbank et al (US 2002/0072688 A1).

17. For claims 1-3, 7, 8, 11, and 12, Burbank et al discloses an electrosurgical cutting apparatus 10 (paragraphs 9-11 and 61), comprising:

- a support member 30 having an internal channel and extending to a forward region;
- a tissue capture component 72 positioned within said interior channel, comprising:
  - a plurality of elongate thin leafs 20,20b (paragraph 34) extending forwardly from a base portion to a leaf tip region 12, a said leaf having a resilient metal drive component 18, 18b extending along a leaf axis from said base portion to a tip region and having a first width at said base portion extending at least to a guide commencement location and configured to define a protective aperture 14 extending across said guide outlet at said tip region,
  - an electrically-insulative, polymeric, flexible leaf cable guide 23 component comprising a sheath (paragraph 33) and having one or more guide channels, the lumen of element 23, reinforced in the vicinity of said guide outlet, disposed parallel with said leaf axis, extending to a guide outlet, the proximal opening of lumen of element 23, configured to surround one or more cables of a pursuing cable assembly between said guide outlet and said guide commencement location,
  - an integrally formed coupling portion 35 mounted with said drive component,
  - said guide channel extending from said tip region along said drive component to said guide commencement location as best seen in Figures 1-7,



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- said leaf assembly being moveable to deploy outwardly from said support member forward region (paragraphs 9-11) , and
- said capture component having a pursing cable 16 assembly extending through said cable guide component guide channel and said guide outlet, electrosurgically energizable and deployable with each said leaf tip region (paragraph 61);
- a drive assembly 24 engageable with said leaf assembly base portion and said pursing cable assembly and actuable to move said leaf assembly to deploy outwardly from said support member while effecting said deployment of said pursing cable assembly (paragraphs 35-37); and
- a control assembly (paragraphs 32, 43) drivably engageable with said drive assembly to effect said actuation thereof and having a terminal electrically coupled with said cable assembly to effect the electrosurgical energization thereof.

18. For claim 4, Burbank et al discloses an electrosurgical cutting apparatus 10, comprising: said leaf drive component 18b wherein a first width is defined between oppositely disposed edges extending from said base portion to said guide commencement location, and is configured having a second full width less than said first width extending from said guide commencement location to said tip region and defining with said first width oppositely disposed shoulders at said guide commencement location, as best seen in Figures 11-13; and said leaf cable guide coupling portion is configured having oppositely disposed rearward end surfaces at said

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guide commencement location extending in abutable support before said oppositely disposed shoulders as best seen in Figures 4-7.

19. For claim 5 Burbank et al discloses an electrosurgical cutting apparatus 10 wherein said leaf drive component 18 is configured having at least one serrated edge, the gears as best seen in Figures 4-7, with rearwardly directed points configured to engage said leaf cable guide component coupling portion 35 when said leafs are moved rearwardly from a deployed orientation toward said support member (paragraphs 9-11, 33, 61).

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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22. Claims 6, 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burbank et al. Burbank et al discloses the claimed invention but does not disclose expressly the dimensions and material compositions of the leaf cable drive and guide components. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the electrosurgical cutting apparatus 10 (paragraphs 9-11 and 61) as taught by Burbank et al with the claimed dimensions and polymer, because Applicant has not disclosed that the dimensions and particular polymer provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with dimensions and materials of the electrosurgical cutting apparatus 10 (paragraphs 9-11 and 61) as taught by Burbank et al, because it provides a means to electrosurgically dissect, encapsulate, and remove tissue and since it appears to be an arbitrary design consideration which fails to patentably distinguish over Burbank et al.

Therefore, it would have been an obvious matter of design choice to modify Burbank et al to obtain the invention as specified in the claim(s).

### ***Conclusion***

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Burbank et al (US 6,540,695 B1) (US 6,958,044 B2) (US 2003/0144605 A1), McGuckin, Jr. et al (US 6,626,903 B2), Gough et al (US 5,683,384), Kortenbach et al (US 2003/0195432 A1), Vetter et al (US 6,936,014 B2), and Ratcliff et

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al (US 5,709,697) each disclose structurally similar tissue biopsy apparatuses with electrosurgical cutting means and/or mechanical tissue removal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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